

REMARKS

The Office Action dated May 5, 2005 has been carefully reviewed and the foregoing amendments have been made as a consequence thereof.

Claims 1-23 are now pending in this application, of which Claim 4 has been amended. Claims 1-23 stand rejected.

The objection to Claim 4 is respectfully traversed.

Claim 4 has been amended adopting the Examiner's suggestion. Accordingly, Applicant respectfully requests that the objection to Claim 4 be withdrawn.

The rejection of Claims 1, 2 and 6 under 35 U.S.C. 103 (a) as being unpatentable over Wallenbrock et al. (U.S. Patent 3,232,071) in view of Swaneck (U.S. Patent 3,759,053) is respectfully traversed.

Wallenbrock et al. describe a refrigerator (10) having an upper cabinet (11) and a lower cabinet (12). The upper cabinet defines a refrigeration chamber (13). A wall (14) extends across the refrigeration chamber to define a lower chamber (15) adjacent a bottom wall (40) of the upper cabinet that has a left hand portion (16) and a right hand portion (17). Pans (18) and (19) are disposed in the left and right hand portions, respectively. The lower cabinet is divided by an upright wall (20) to define a left hand freezer chamber (21) and a right hand refrigeration chamber (22). Air from an evaporator (24) is delivered through a first duct (29) to the refrigeration chamber and through a second duct (30) to the freezer chamber. An outlet (61) in the duct leads to a metered outlet (61a) that admits air into the chamber portion (16). A manually operated damper (62) controls the metered outlet to adjust the temperature in the chamber portion from slightly below freezing to slightly above freezing so that the pan may be used as either a meat pan or a crisper. Notably, the refrigerator includes a passage (107) between

the lower wall (40) and the lower cabinet that is occupied by a cutting board that may be moved forwardly and rearwardly into the space (107) as desired (col. 6, lines 11-19). The lower cabinet includes the freezer chamber.

Swaneck describes an air control for a quick chill compartment in a refrigerator. The refrigerator (10) includes a freezer compartment (12) and a quick chill compartment (14) in a portion of a fresh food compartment (16). A fan (18) in the freezer compartment circulates cooling air within the freezer and to the quick chill and fresh food compartments through a flow path (20). As shown in Figure 1, the flow path includes a passageway (24) through a dividing wall (26) that opens into a passageway (28) formed by a pair of side walls (30, 32) extending from the dividing wall (26) inwardly into the quick chill compartment and forming a part of a housing (35). A damper (22) is positioned at the end of the passageway remote from the dividing wall to control air flow into the quick chill compartment. A second quick chill damper (58) is positioned in a second housing (60) in the quick chill compartment. The damper (58) is positioned adjacent the dividing wall at a passageway (70) formed in the dividing wall that is part of a second flow path (72). A passageway (68) extends from the dividing wall through the housing (60) and exits into a fan inlet. When operating, the fan draws air through the flow path (72), through the fan, and into the quick chill compartment.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Wallenbrock in view of Swaneck. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination

that was made by the applicant." *In re Kotzab*, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

The Office Action suggests that the one of ordinary skill in the art would be motivated to modify Wallenbrock according to the teachings of Swaneck to provide a duct "located entirely in the dividing wall, with addition of an inlet in the top of the freezer compartment...". However, the Wallenbrock refrigerator includes a space (107) between the bottom wall (40) and the lower compartment, including the freezer chamber, in which a cutting board (108) is movably disposed. Thus, it is not possible to locate a duct entirely in the dividing wall in Wallenbrock and also have the duct inlet in the freezer chamber without extensive modification of Wallenbrock, including frustration of the cutting board feature.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Further, in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied,

469 U.S. 851 (1984). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, the modification of Wallenbrock to have a duct entirely within the dividing wall would require the elimination of the cutting board space and the cutting board. Thus, Applicant respectfully submits that the combination of Wallenbrock and Swaneck cannot support a prima facie case of obviousness. For the reasons set forth above, Applicants respectfully request that the 103 rejection of Claims 1, 2, and 6 be withdrawn.

Claim 1 recites a refrigerator including “a refrigeration compartment; a freezer compartment adjacent said refrigeration compartment; a dividing wall defining a third compartment adjacent said freezer compartment and separated from said freezer compartment by said dividing wall, said third compartment controllable in both a refrigeration mode and a freezer mode; and a duct extending through said dividing wall from a top surface of said dividing wall to a bottom surface of said dividing wall and delivering air from said freezer compartment to said third compartment, and wherein said duct is open to said freezer compartment at one of said top and bottom surfaces”.

Neither Wallenbrock et al. nor Swaneck, considered alone or in combination, fairly describe or suggest a refrigerator as recited in Claim 1. More specifically, neither Wallenbrock et al. nor Swaneck, considered alone or in combination, fairly describe or suggest a dividing wall defining a third compartment and a duct extending through the dividing wall from a top surface to a bottom surface of the dividing wall and delivering air from the freezer compartment to the third compartment, and wherein the duct is open to the freezer compartment at one of the top and bottom surfaces. Rather, Wallenbrock et al describe a refrigerator having a compartment adjacent a bottom wall that is spaced apart from a freezer compartment wall. Swaneck describes damper controlled air passageways between a freezer compartment and a quick chill

compartment. Accordingly, for the reasons set forth above, Claim 1 is submitted to be patentable over Wallenbrock et al. in view of Swaneck.

Claims 2 and 6 depend from the independent Claim 1. When the recitations of Claims 2 and 6 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2 and 6 likewise are patentable over Wallenbrock et al. in view of Swaneck.

For at least the reasons set forth above, Applicant respectfully requests that the §103 rejection of Claims 1, 2 and 6 be withdrawn.

The rejection of Claims 3, 4, 5, and 7 under 35 U.S.C. 103(a) as being unpatentable over Wallenbrock et al. in view of Swaneck as applied to Claim 1, and further in view of Peterson et al. (U.S. Patent No. 5,758,512) is respectfully traversed.

Wallenbrock et al. and Swaneck are described above. Peterson et al. describe a refrigerator (20) having a middle fresh food compartment (30) and a bottom freezer compartment (34) arranged below the fresh food compartment and a small freezer compartment (26) arranged above the fresh food compartment. Cool air can be directed to the compartments of the refrigerator by use of a baffle assembly (96) which includes a main rotary damper (102) which can be positioned to provide proportional amounts of chilled air to the three separate compartments based on the degree of cooling required.

Claims 3, 4, 5, and 7 depend from Claim 1, which recites a refrigerator including “a refrigeration compartment; a freezer compartment adjacent said refrigeration compartment; a dividing wall defining a third compartment adjacent said freezer compartment and separated from said freezer compartment by said dividing wall, said third compartment controllable in both a refrigeration mode and a freezer mode; and a duct extending through said dividing wall from a top surface of said dividing wall to a bottom surface of said dividing wall and delivering air from

said freezer compartment to said third compartment, and wherein said duct is open to said freezer compartment at one of said top and bottom surfaces”.

None of Wallenbrock et al., Swaneck, and Peterson et al., considered alone or in combination, fairly describe or suggest a refrigerator as recited in Claim 1. More specifically, none of Wallenbrock et al., Swaneck, and Peterson et al., considered alone or in combination, fairly describe or suggest a dividing wall defining a third compartment and a duct extending through the dividing wall from a top surface to a bottom surface of the dividing wall and delivering air from the freezer compartment to the third compartment, and wherein the duct is open to the freezer compartment at one of the top and bottom surfaces. Rather, Wallenbrock et al. describe a refrigerator having a compartment adjacent a bottom wall that is spaced apart from a freezer compartment wall. Swaneck describes damper controlled air passageways between a freezer compartment and a quick chill compartment. Peterson et al. describe a refrigerator wherein a fresh food compartment is disposed between the freezer compartment and the third compartment such that the dividing wall has no surface open to the freezer compartment. Accordingly, for the reasons set forth above, Claim 1 is submitted to be patentable over Wallenbrock et al. in view of Swaneck and further in view of Peterson et al.

Claims 3, 4, 5, and 7 depend from the independent Claim 1. When the recitations of Claims 3, 4, 5, and 7 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 3, 4, 5, and 7 likewise are patentable over Wallenbrock et al. in view of Swaneck and further in view of Peterson et al.

For at least the reasons set forth above, Applicant respectfully requests that the §103 rejection of Claims 3, 4, 5, and 7 be withdrawn.

The rejection of Claims 8-23 under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Patent No. 5,551,252) in view of Peterson et al. and further in view of Swaneck is respectfully traversed.

Peterson et al. and Swaneck are described above. Lee describes a refrigerator including a refrigeration compartment (16), an individual compartment (20), a freezer compartment (15) and a vegetable compartment (32). A first wall (40) is formed between the refrigeration compartment and the freezing compartment and a second wall (30) is formed between the freezing compartment and the vegetable compartment. A rear wall (15W) of the freezing compartment includes a heat exchanging compartment (H) including an evaporator (17) and fan (18). A main duct (50) extends vertically through the first wall and delivers air to the various compartments. A main damper (51) is mounted in an upper portion of the main duct to control the flow of cool air from the heat-exchanging compartment into the refrigerating compartment. Individual dampers (52, 53) control the flow of cool air from the heat-exchanging compartment into respective chambers (21, 23). A cool air passage (70) in the second wall returns air from the freezing and vegetable compartments to the evaporator. Openings (61) and (67) on the freezing compartment side of the second wall along with opening (65) on the vegetable compartment side of the second wall all admit air from the respective compartments into the cool air passage for delivery to the evaporator.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Lee according to the teachings of Swaneck and Peterson. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, "to establish obviousness based on a combination of the elements disclosed in

the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Further, under Section 103, "it is impermissible...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicant's disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991).

The Office Action suggests that it would have been obvious to modify Lee by having a duct located entirely in the dividing wall with an inlet in the top of the freezer compartment in order to provide direct flow between the compartments insuring a quick chill. However, this changes the principle of operation of the Lee refrigerator. In Lee, a cool air passage (70) in the second wall returns air from the freezing and vegetable compartments to the evaporator. Openings (61) and (67) on the freezing compartment side of the second wall along with opening (65) on the vegetable compartment side of the second wall all admit air from the respective compartments into the cool air passage for delivery to the evaporator rather than conveying air from the freezing compartment to the vegetable compartment. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Claim 8 recites a refrigerator including "an upper compartment including an evaporator and a fan therein, said evaporator and said fan enclosed by an evaporator cover having an inlet and an outlet; a dividing wall defining a lower compartment separated from said

upper compartment by said dividing wall; a duct extending through said dividing wall from a top surface of said dividing wall to a bottom surface of said dividing wall and delivering air from said upper compartment to said lower compartment, and wherein said duct is open to said upper compartment at said top surface, said duct having a damper disposed therein for opening and closing said duct, said duct having a duct fan disposed therein; and a supply conduit having a first end and a second end, said first end coupled to said evaporator cover, and said second end coupled to said duct such that said supply conduit provides flow communication from said evaporator to said duct”.

None of Lee, Peterson et al., and Swaneck, considered alone or in combination, fairly describe or suggest a refrigerator as recited in Claim 8. More specifically, none of Lee, Peterson et al., and Swaneck, considered alone or in combination, fairly describe or suggest a dividing wall defining a lower compartment and a duct extending through the dividing wall from a top surface to a bottom surface of the dividing wall and delivering air from the upper compartment to the lower compartment, and wherein the duct is open to the upper compartment at the top surface. Rather, Lee describes a refrigerator having a dividing wall having openings at the top and bottom surfaces that take in air from both the upper and lower compartments for delivery to an evaporator. Peterson et al. describe a refrigerator wherein a fresh food compartment is disposed between the upper compartment and the lower compartment such that the dividing wall has no surface open to the upper compartment. Therefore no air is delivered from the upper compartment to the lower compartment through a duct open to the upper compartment at the top surface of the dividing wall. Swaneck describes damper controlled air passageways between a freezer compartment and a quick chill compartment. Accordingly, for the reasons set forth above, Claim 8 is submitted to be patentable over Lee in view of Peterson et al. and further in view of Swaneck.

Claims 9-14 depend from independent Claim 8. When the recitations of Claims 9-14 are considered in combination with the recitations of Claim 8, Applicant submits that dependent

Claims 9-14 likewise are patentable over Lee in view of Peterson et al. and further in view of Swaneck.

Claim 15 recites a refrigerator compartment including “an upper compartment...a dividing wall defining a lower compartment separated from said upper compartment by said dividing wall, said dividing wall having a top surface and a bottom surface;...a second duct extending through said dividing wall providing an opening from said top surface to said bottom surface and delivering air from said upper compartment to said lower compartment, said second duct being open to said upper compartment at said top surface...and a gate damper coupled to said top surface of said dividing wall...”.

None of Lee, Peterson et al., and Swaneck, considered alone or in combination, describe or suggest a refrigerator compartment as recited in Claim 15. More specifically, none of Lee, Peterson et al., and Swaneck, considered alone or in combination, describe or suggest a dividing wall defining a lower compartment and having top and bottom surfaces, and a second duct extending through the dividing wall providing an opening from the top surface to the bottom surface and delivering air from the upper compartment to the lower compartment, and wherein the second duct is open to the upper compartment at the top surface, and a gate damper coupled to said top surface of the dividing wall. Rather, Lee describes a refrigerator having a dividing wall having openings at the top and bottom surfaces that take in air from both the upper and lower compartments for delivery to an evaporator. Further, the damper (51) in Lee is not coupled to the top surface of the dividing wall. Peterson et al. describe a refrigerator wherein a fresh food compartment is disposed between the upper compartment and the lower compartment such that the dividing wall has no surface open to the upper compartment. Therefore no air is delivered from the upper compartment to the lower compartment through a duct open to the upper compartment at the top surface of the dividing wall. Swaneck describes a damper at the quick chill side or bottom side of a duct. Accordingly, for the reasons set forth above, Claim 15 is submitted to be patentable over Lee in view of Peterson et al. and further in view of Swaneck.

Claims 16-23 depend from independent Claim 15. When the recitations of Claims 16-23 are considered in combination with the recitations of Claim 15, Applicant submits that dependent Claims 16-23 likewise are patentable over Lee in view of Peterson et al. and further in view of Swaneck.

For at least the reasons set forth above, Applicant respectfully requests that the §103 rejection of Claims 8-23 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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